

HEWLETT-PACKARD COMPANY
Legal Department, IPA Section, ms: 35
P O BOX 272400
3404 East Harmony Road
Fort Collins, CO 80528-9599

PATENT APPLICATION
Attorney Docket No: 200312175-1
Application No. 10/765,628

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: **Timothy D. Strecker et al.** **Examiner:** **Melvin Cartegena**
Application No: **10/765,628** **Group Art Unit:** **3754**
Filing Date: **January 27, 2004** **Confirmation No:** **2262**
Title: **DISPENSING APPARATUS INCLUDING A CERAMIC BODY**

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PETITION TO DIRECTOR UNDER 37 CFR §1.181 and

PETITION FROM REQUIREMENT FOR RESTRICTION (37 CFR §1.144)

Dear Sir:

Applicant petitions the Director to review and withdraw the Restriction Requirement of October 10, 2006 issued in the present application. An election with traverse was made on November 6, 2006.

Remarks

This Petition is in response to the Restriction Requirement of October 10, 2006. Applicant has requested reexamination and reconsideration, and has traversed the restriction in an election filed November 9, 2006. This petition is being submitted not later than appeal. Thus, the petition should be considered under 37 CFR 1.144 and 37 CFR 1.181.

Applicant respectfully submits that the restriction fails to establish a prima facie case for the propriety of the restriction requirement. MPEP 808.01 requires the Examiner to provide particular reasons for holding that the inventions as claimed are either independent or distinct and that those reasons should be concisely stated. The restriction fails to comply with MPEP 808.01 and thus the restriction cannot stand. In addition, MPEP §806.05(j) requires claims to related products to be distinct if the inventions are mutually exclusive, not obvious variants, and are either not capable of use together or can have a materially different design, mode of operation, function or effect. The restriction fails to comply with MPEP §806.05(j) and thus the restriction cannot stand. Further, Examiner has improperly withdrawn claims to Applicant's elected species arguing the claims read on a non-elected species instead of determining whether the claims are readable on the elected species.

Therefore, the restriction is unwarranted and should be withdrawn. A more detailed explanation of the restriction and Applicant's supporting rationale is provided as follows.

Summary of The Restriction

The Restriction of October 10, 2006 required restriction to one of the following species under 35 U.S.C. 121, as follows:

Species 1, the embodiment shown in Fig. 1, teaches a dispensing apparatus that includes a drive mechanism rotationally coupled to a feed screw through a drive shaft. The feed screw, includes helical threads in sliding contact with a sidewall of a chamber formed in a ceramic body where the helical threads have a liner pitch. The ceramic body also includes an inlet channel through which a viscoelastic fluid is introduced into the chamber.

Species 2, the embodiment shown in Figs. 2a-2d, teaches a removable ceramic insert is received in a housing that includes a main body portion and a front body portion. The front body portion is attached to the main body portion at a pivot point through a hinge so that the front body portion pivots away from the main body portion when a locking mechanism is released. The removable ceramic insert is insertable into the main cavity of housing as shown in Fig. 2b. An inlet channel fits within an input cavity formed in the housing and extends outside of the housing to fluidically couple to a fluid reservoir. The feed screw has a helical pitch that decreases as the threads approach a second portion of the ceramic insert.

Species 3, the embodiments shown in Figs. 3 and 4, teach a dispensing apparatus that mixes two different fluid components to form a viscoelastic fluid product; and accurately dispenses a pre-selected amount of the viscoelastic fluid product utilizing a feed screw to both mix and dispense the viscoelastic fluid product, where the feed screw has a conical or tapered shape with a linear pitch. In Fig. 3 the first and second inlet channels are in fluid communication with the chamber via first and second inlet ends. As shown in Fig. 3 the second inlet end of the second inlet channel opens into the chamber at a point closer to the first portion of the ceramic body than the first inlet end of the first inlet channel. The first inlet end and the second inlet end are separated in a direction along the axis of the chamber that precludes

interaction of first and second component fluids in either of the inlet channels. Fig. 4 teaches an alternate embodiment where the first and second inlet channels extend radially from the chamber formed in the ceramic body. The first and second inlet channels are separated in a direction along the axis of the chamber to preclude the interaction of a first and a second component fluid from either inlet channel as first and second component liquids are fed into the chamber from first and second reservoirs. However, Fig. 4 is silent on the number of feed screws as well as the shape and pitch of the feed screws.

Species 4, the embodiment shown in Fig. 5, teaches where the first and second inlet channels are attached to the chamber at a common location. The angle formed between the axes of the inlet channels is acute. Again Fig. 5 is silent on the number of feed screws as well as the shape and pitch of the feed screws.

Species 5, the embodiment shown in Figs. 6a-6c, teaches an alternate embodiment, where two feed screws are located within a chamber as shown in Figs. 6a-6c. The chamber includes two circular bores formed in a ceramic body that have parallel axes and extend centrally and longitudinally through the ceramic body. The circular bores communicate with each other along a common chord. The two feed screws are rotatably supported within the circular bores of the chamber. In addition, the helical threads of the feed screws are partly overlapping and linear in pitch.

Species 6, the embodiment shown in Figs. 7a-7b, teaches an alternate embodiment where the two feed screws are located within a ceramic chamber that includes two non-overlapping cylindrical bores and the two feed screws have a linear pitch.

Species 7, the embodiment shown in Figs. 8a-8b, teaches an alternate embodiment where the feed screw may be heated by a feed screw heater and the ceramic body may be heated by body heaters. The feed screws shown have a linear pitch. The feed screw heater and body heaters are electrically coupled to a temperature

controller to control the temperature of the feed screw and the ceramic body. However, Figs. 8a and 8b are silent on the number of inlet channels.

Election

In response to the Restriction Requirement, Applicant filed an election with traverse on November 9, 2006 and elected to prosecute Species 7. A listing of claims readable on the Elected Species was identified by Applicant as Claims 1-4, 12-23, 25-35, 37-44, and 48-59. In the subsequent Office Action issued on February 23, 2007, claims 2-11, 14, 24, 26-34, 36, 39, 40, and 43-47 were withdrawn by the Examiner with the Examiner stating that claims 2-4, 14, 39-40, and 43-44 do not read on the elected species because those claims are directed to embodiments with multiple inlets to the dispensing apparatus. Applicant traverses Examiner's statement. Applicant argues the claims do read on the elected species exactly because the elected species is generic to the other species Examiner choose to identify. That is Species 7 does not distinguish embodiments to different numbers of inlets, or the presence or absence of a housing and therefore is not mutually exclusive of at least some of the other species and in particular species to multiple inlet channels.

Looking to the Restriction, it proposes on page 2, with a simple conclusory statement that seven different groupings of figures represent 7 species that "are independent or distinct because they are directed to related products." Applicant respectfully submits that a claim that covers a feed screw that maybe heated or a ceramic body that may be heated is a related product that reads on a claim with either one or two inlet ports, reads on a claim with a removable insert, and reads on a claim that include a housing. Thus, either Species 7 is not a distinct species that requires restriction or at least some of Species 1-6 are not distinct species that requires restriction.

Traversal Argument Against Restriction

A. Restriction is Not proper since the reasons relied on have not been presented MPEP §808.01, MPEP §808.01(a), and MPEP §809.02(a)

MPEP §808.01 Reasons for Holding of Independence or Distinctness, first paragraph states:

The particular **reasons relied on** by the examiner for holding that the inventions as claimed are either independent or distinct **should be concisely stated. A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given. *Emphasis added.*

MPEP §808.01(a) Species, the second paragraph states:

Where there is a relationship disclosed between species, **such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction**, in order to establish the propriety of restriction. *Emphasis added.*

MPEP §809.02(a) Election of Species Required, paragraph (B) states:

“Provide reasons why the species are independent or distinct.”

Applicant respectfully submits MPEP §808.01, requires Examiner to concisely state the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct and specifically states a mere statement of conclusion is inadequate. In the Restriction on page 2, the rationale provided by Examiner simply makes the conclusory statement "The species are independent or distinct because they are directed to related products." No further explanation is given. Applicant asserts such a conclusory statement does not satisfy the burden and does not comply with the standards of establishing a proper restriction requirement. Since no evidence has been presented that the species are independent or distinct, a *prima facie* case for the propriety of the restriction requirement has not been presented. Even Examiner's response in the Office Communication dated February 23, 2007 is still a mere conclusory statement that some of the species are "different," where Examiner states "because an apparatus moving a single product from a single inlet port towards

an outlet port by a rotatory[sic] vane is different than[sic] an apparatus moving and mixing multiple products form[sic] multiple inlet ports towards an[sic] single or multiple rotatory[sic] vanes. Heated dispensers are very specific and only required with[sic] to dispense specialized products." Applicant traverses Examiner's statements in regards to the restriction requirement made in the Office Communication dated February 23, 2007. Applicant asserts Examiner's statement that "[h]eated dispensers are very specific and only required with[sic] to dispense specialized products," is on its face without merit and false. Applicant asserts heated dispensers can be used at least for a wide variety products and most likely can be used to dispense any viscoelastic product. In addition, Examiner then makes the mere conclusory statement that the "species are mutually exclusive," without providing any reasoning as to how they are mutually restrictive. Thus, the restriction must be withdrawn. Additionally, since no evidence was provided in Examiner's restriction requirement, Applicant was not provided a meaningful opportunity to respond. Applicant was left to guess as to Examiner's reasoning for the restriction and was left to guess as to why Examiner choose to identify 7 species based on figures 1-8 when other species exist in the application that clearly would be meet the requirements for restriction and therefore would be proper. As just one of several examples Applicants assert that one proper species is to two feed screws having intermeshing feed screws and another proper species is to two feed screws having non-intermeshing feed screws. These are proper species since they are clearly mutually exclusive as required under MPEP §806.05(j) and 806.04(f).

In addition, Examiner's mere conclusory statement does not even state whether the species are independent or whether they are distinct. MPEP §808.01(a) states "[w]here there is no disclosure of a relationship between species (see MPEP § 806.04(b)), they are independent inventions." Applicant believes, most likely, that Examiner is not arguing that the species are independent, however, Applicant is not sure since Examiner has made no clear statement that the species are distinct as Examiner merely states the species are "different" in the Office Communication dated February 23, 2007. However, assuming for the moment that Examiner may be arguing that the species are distinct then MPEP §808.01(a) also states "[w]here there is a

relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction. Examiner's mere conclusory statement provides no discussion and provides no reasons for one to conclude that the disclosed relation allows for restriction, i.e. does not prevent restriction. Since no evidence has been presented that the related products require restriction, a *prima facie* case for the propriety of the restriction requirement has not been presented.

B. Restriction is not proper since the species identified are to related products at least some of which are not distinct according to MPEP §806.05(j)

As an additional reason for traversal, Applicant respectfully submits that claims to related products, under MPEP §806.05(j), are distinct if the inventions are:

mutually exclusive,

not obvious variants, and

are either not capable of use together or can have a materially different design, mode of operation, function or effect. Clearly, Examiner has neither provided any explanation how all 7 species identified by Examiner are mutually exclusive nor provided any explanation how all 7 species have a materially different design, mode of operation, function or effect, since Applicant believes Examiner can not reasonably be arguing the species are not capable of use together when in fact they clearly are capable. Thus, for this additional reason the restriction must be withdrawn.

In addition, Applicant is also left to guess as to whether or not Examiner has considered that all 7 species are not obvious variants as Examiner remains silent on that issue. Examiner is silent on whether Examiner has grouped together species considered clearly unpatentable over each other, i.e. are not obvious variants of each other. MPEP 806.04(h) clearly states "[i]n making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other." Applicant pointed this out to Examiner in Applicant's response to the restriction requirement. Examiner continues

to remain silent in regards to Examiner's grouping of figures and thus, Applicant assumes Examiner is clearly asserting that all of the identified species described in the restriction requirement are clearly patentable over each other and are not obvious variants including Species 3 and 4. As noted above since Examiner has remained silent on providing any reasoned explanation of Examiner's choice of species Applicant is left to guess as to what distinguishing characteristic Examiner is using to separate Species 3 from Species 4. Thus, for this additional reason the restriction must be withdrawn.

C. Restriction is not proper because Examiner has improperly withdrawn claims that read on Applicant's elected species

As an additional reason for traversal, MPEP 806.04(e) clearly states the "scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim. Alternatively, a claim may encompass two or more of the disclosed embodiments (and thus be designated a generic or genus claim). Applicant argues the grouping of figures the Examiner has identified as species does not represent the proper species found within Applicant's application but rather Examiner has identified various embodiments that represent examples of various subcombinations common to various species found in Applicant's invention. Thus, Examiner has not identified the proper distinct and mutually exclusive species that requires restriction. Applicant asserts Examiner appears to have arbitrarily picked all the figures. In addition, Applicant asserts without some reasoned explanation by the Examiner Applicant is left to guess as to exactly what specific features shown in a particular figure Examiner is relying on to identify a proper species that is an independent or distinct species and meets all the other requirements such as mutually exclusive when compared to the other species or figures Examiner has identified. For example, Examiner identifies Species 3 as **the embodiment** shown in Figs. 3 and 4 when in fact it is at least two embodiments, namely that shown in Fig. 3 and the embodiment shown in Fig. 4. Thus, what is Examiner's reasoning and specific features Applicant is to rely on to identify which claims read on this species. Is Applicant to identify a tapered feed screw as the main limitation or just one of several? Is the linear pitch which is common to several figures a limitation that is to be restricted or the

presence of two inlet channels as apparently Examiner is arguing? But then if it is the presence of two inlet channels is it two inlet channels separated in a direction along the axis of the chamber or is it as shown in Fig. 3 the angle formed by the inlet channels when compared to Fig. 4. Applicant asserts that any claim limitation that is not in contradistinction of Figs. 3 and 4 reads on the species shown in Figs. 3 and 4. That is a claim to a linear pitch reads on Species 3 as well as reading on Species 1, and 4-7 where as a claim to a feed screw having a conical or tapered shape reads only on Species 3 and a claim to two feed screws clearly does not read on Species 3. In contrast, if one looks at Species 7 Applicant is left to ask which claims read on this species. Applicant argues that there is clearly nothing in Figs. 8a or 8b that precludes any number of inlet channels since Species 7 is silent on the number of inlet channels. Thus claims to both 1 inlet channel and 2 inlet channels read on Species 7 regardless whether Examiner has improperly identified another Species that also reads on two inlet channels. Applicant asserts that Examiner cannot choose to use a figure to describe a species and then arbitrarily ignore what the figure shows and further restrict claims to that particular species beyond what is shown thereby creating an even more narrower species as compared to the figure. Applicant can only ask why Examiner has chosen a single inlet channel rather than restrict out one inlet channel and say species 7 reads only on two inlet channels. Examiner's argument that claims to two inlet channels read on an unelected species is without merit since claims to 1 inlet channel read on Species 1 which is also an unelected species. Following Examiner's argument leads to the absurd result that Species 7 does not read on claims to any number of inlet channels. Applicant asserts Examiner's withdrawal of at least claims 2-4 and 14 is improper. Applicant has presented arguments to the Examiner that the heating elements shown in Figs. 8a and 8b may be utilized in any of the embodiments shown in Figs. 1-7, i.e. embodiments with one or two inlets may utilize any of the heating arrangements shown in Figs. 8a and 8b. Therefore, clearly claims to one or two inlet channels are common to Species 7 by the definition given above, in regards to species specific claims. Thus, for this additional reason the restriction must be withdrawn.

D. Restriction is not proper since no undue burden has been established by Examiner in accordance with MPEP §803

As an additional reason for traversal, Examiner's restriction requirement has not established that an undue burden would be required if the restriction requirement either was not issued or if issued with fewer species. More particularly, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Examiner has clearly demonstrated that no undue burden exists in examining fewer species since in the first Office Action on the merits Examiner has searched and Examiner has rejected claims reading on Species 1 involving a single inlet and single feed screw having a linear pitch and has rejected claims reading on Species 2 involving a housing and a removable ceramic insert is insertable into the main cavity of the housing in addition to examining those claims reading on Applicant's elected Species 7. Thus, in the present application, no undue burden has been established if the claims to two inlets were examined as Applicant originally thought would be examined and continues to maintain Examiner's withdrawal of those claims is improper.

The present restriction requirement not only improperly shifts the Examiner's burden to the Applicant, but also subjects Applicant to the added financial burden of prosecuting different claims in an unreasonable number of separate proceedings. Thus, for this additional reason the restriction must be withdrawn.

E. Restriction is not proper since species are not mutually exclusive MPEP 806.04(f)

As an additional reason for traversal, a comparison of the limitations and scope of each dependent claim shows that the claims overlap in scope and therefore, the

species are not mutually exclusive. Accordingly, restriction between claims limited to species should not be required based on MPEP 806.04(f), which states:

MPEP 806.04(f) Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. [Emphasis Added]

In the present application, the identified species are not mutually exclusive and the claims overlap in scope since Species 7 does not include any limitations on the number of inlet channels associated with the various heater arrangements shown in Figs. 8a and 8b. Therefore in view of MPEP 806.04(f), the restriction is improper and should be withdrawn. Thus, for this additional reason the restriction must be withdrawn

F. Restriction is not proper since restriction to 7 species is more than a reasonable number of species 37 C.F.R. §1.146

Finally, as an additional reason for traversal, Examiner has failed to provide any explanation how a seven way restriction is a reasonable number of species since "the examiner may require restriction of the claims to not more than a reasonable number of species . . ." 37 C.F.R. §1.146. Examiner has provided no reasoned explanation of why claims to species 1 and 2 or claims to species 5 and 6 cannot be examined together without causing any undue burden. Thus, for this additional reason the restriction must be withdrawn.

HEWLETT-PACKARD COMPANY
Legal Department, IPA Section, ms: 35
P O BOX 272400
3404 East Harmony Road
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Conclusion

For the reasons set forth above, the restriction is unwarranted and should be withdrawn. Applicant respectfully requests that the Director withdraw the restriction for all claims.

Hewlett-Packard Company
1000 NE Circle Blvd. m/s 422B
Corvallis, OR 97330
(541) 715-1694

Respectfully submitted,
Timothy D. Strecker et al.

By: /Donald J. Coulman/
Donald J. Coulman
Reg. No. 50,406
Attorney for Applicant

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